

REMARKS

Claims 1-12 are pending in the application, claims 13-20 are withdrawn, and claims 21-36 are cancelled. Claims 6 and 12 are rejected under 35 USC 112, second paragraph as being indefinite. In order to expedite prosecution, applicants hereby cancel claims 6 and 12. Claims 1-5 and 7-11 are rejected under 35 USC 103(a) as being unpatentable over Heath et al (US 5668152) in view of Comford et al (AJP, v. 143, No. 1 (1999) 137-1244). In view of the reasons set forth below, it is submitted that the present rejection is improper and should be withdrawn. Reconsideration and reexamination of the present application in view of the amendments and remarks presented herein is respectfully requested.

Rejection under 35 USC 112-Indefiniteness

In view of the cancellation of claims 6 and 12, this rejection is rendered moot.

Rejection under 35 USC 103(a)

With respect to evidence submitted in a declaration in response to the prior office action, the Examiner asserts that:

“First, recognition of additional pathways does not provide sufficient evidence to overcome the obviousness rejection where one of ordinary skill in the art would have chosen the compound of the primary reference and cancer of the secondary reference for different reasons, i.e., the protein kinase C inhibition function. Second, the evidence is directed to a property which is not instantly claimed, where there are multiple pathways which may be inhibited, thereby treating cancer.”

The argument supports at most an assertion that the claimed invention is *prima facie* obvious. Yet, regardless of whether it would have been obvious for someone of ordinary skill in the art to choose the claimed compounds to treat prostate cancer, Applicants supporting data in the declaration is sufficient to rebut this assertion by demonstrating the superior activity of the claimed compounds in prostate cancer versus a structurally related compound. The substantial difference in activity could not have been predicted based upon the protein kinase C inhibition alone. It is possibly due to the dual mechanism of the claimed compounds discovered by Applicants. These results are consistent with an assertion that the field of the invention is highly unpredictable.

Further, the office action infers that Applicants merely provided evidence in the declaration demonstrating that the claimed compounds have substantially more AKT-receptor activity compared to the structurally related compound enzastaurin (see table 1). This misconstrues the evidence. For example, Figures 1 and 2 of the declaration

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demonstrate that, in addition to having substantial AKT-receptor activity, the claimed compounds are also unexpectedly more effective against specific tumor cell lines, regardless of the mechanism(s) involved.

Therefore, it is submitted that the present rejection is improper and should be withdrawn. Reconsideration and reexamination of the present application in view of the amendments and remarks presented herein is respectfully requested.

Please charge any fees or credit any overpayment in connection with this application which may be required by this or any related paper to Deposit Account No. 05-0840.

If the Examiner has any questions or would like to discuss any matters in connection with this application, he is invited to contact the undersigned attorney at (317) 276-0307.

Respectfully submitted,

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